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EXAMINER				
BILAS, ROBERT				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/509,786

Applicant(s)

ISHII ET AL.

Examiner

ROBERT BILAS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10 and 12-29 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-8,10 and 12-29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on 13 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/29/04
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Objections

1. Claim 8 is objected to because of the following informalities: A claim must end with a single period ".". The third paragraph of claim 8 has a period at the end. The necessary change is from "." to --;- Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 8 and 29 are rejected under 35 U.S.C. 101 because the claims are directed to non-statutory subject matter. Claim 1 recites a "system". In this case, the "system" can be implemented in a manner that uses only software.

Claim 8 recites a mail receiving means for, mail storing means for, mail transmitting means for, user data storage means for, notice determination means for, timer management means for, mail arrival notice means for, transmission data storage means for, network connection means for, mail arrival notice means for, notice transmission means for, network connection control means for, retransmission data storage means for, retransmission control means for and retransmission data deletion means for. According to Applicant's specification, these "means for" recitations can be implemented by using only software.

Claim 29 recites a mail receiving means for, mail storing means for, mail transmitting means for, user data storage means for, notice determination means for, timer management means for, mail arrival notice means for, transmission data storage means for and network connection means for. According to Applicant's specification, these "means for" recitations can be implemented by using only software.

Each of these claims are not statutory because they recite the abstract idea of software and are not directed to a process occurring as a result of executing the software on an actual physical device. For a claim to be statutory, an actual hardware device is required. These claims do meet this criterion and are therefore deemed non-statutory. **See MPEP Chapter 2106.01 Section I**

Claim Construction

3. In claim 8 the mail receiving means; mail storing means; mail transmitting means; user data storage means; notice determination means; timer management means; mail arrival means; transmission data storage means; network connection means; mail arrival notice means; notice transmission means; network connection means; retransmission data storage means; retransmission control means and retransmission data deletion means are being construed under 112 6th paragraph.

In claim 10, transmission data deletion means is being construed under 112 6th paragraph. In claim 28, mail receiving means; mail storing means; mail transmitting means; user data storage means; notice determination means; timer management

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means; transmission data storage means and network connection means are being construed under 112 6th paragraph.

In claim 29, mail receiving means; mail storing means; mail transmitting means; user data storage means; notice determination means; timer management means; mail arrival notice means; transmission data storage means and network connection means are being construed under 112 6th paragraph.

Claim Rejections - 35 USC § 112

4. Claims 1, 3 – 8, 10 and 12 - 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is not any corresponding structure; therefore the meaning of these claim elements is unclear. For the purposes of applying art, these elements have been construed as being software.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 – 8, 10, 12 – 25 and 28 – 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Hammond, U. S. 6854007.

For claim 1, Hammond teaches "A mail arrival notice system comprising: a mail delivery device (see Message Review Server, block 132 of fig. 1), for delivering mail received through the Internet to terminals (see blocks 150, 160, 170 and 180 of fig. 1); and terminals for requesting arrival notice of receive mail (see block 127 of Fig. 1) under conditions set in advance for said mail delivery device (see column 3 lines 18 - 27); wherein, when mail arrival notice to said terminals from said mail delivery device fails, said mail arrival notice data is stored (see block 127 and 130 of fig. 1), and the mail arrival notice is transmitted to said terminals again after a predetermined time elapses (see fig. 3A, 3B), while, when said mail arrival notice is successfully transmitted, said stored mail arrival notice data is deleted (column 8, lines 61 - 63) from said mail delivery device; and when said mail delivery device, after storing said mail arrival notice data, receives other mail directed to said terminals, it temporarily stops transmission of said stored mail arrival notice data, and releases said transmission temporarily stopped when arrival notice of said other mail fails (See column 8, lines 50 – 63).").

For claim 3, Hammond teaches The mail arrival notice system according to claim 1, wherein, when said mail delivery device, after storing said mail arrival notice data, receives other mail directed to said terminals, it deletes said stored mail arrival notice data (see column 8, lines 61 – 63).

For claim 4, Hammond teaches The mail arrival notice system according to claim 1, wherein said mail delivery device can set any number of retransmissions of mail arrival notice (see Abstract, lines 11 - 17).

For claim 5, Hammond teaches The mail arrival notice system according to claim 1, wherein said mail delivery device changes conditions for transmitting mail arrival notice to said terminals, based on reasons for failure in transmission (see column 2, lines 11 - 30).

For claim 6, Hammond teaches The mail arrival notice system according to claim 1, wherein, in the case where a user of said terminals has plural terminals of different types, when mail arrives in the user, said mail delivery device assigns priorities to said plural terminals and transmits mail arrival notice (See fig. 2 and column 7, lines 17 - 20).

For claim 7, Hammond teaches The mail arrival notice system according to claim 6, wherein said mail delivery device, when said mail arrives, assigns priorities to said plural terminals, based on one of mail contents, notice conditions, and terminal capabilities, or combinations of two or more of these items (See column 7, lines 17 - 20).

For claim 8, Hammond teaches A mail delivery device in a system including the Internet for delivering mail, a mail delivery device, connected to the Internet, for creating mail arrival notice to notify terminals of the arrival of said mail, a public network, connected to said mail delivery device, for relaying said mail arrival notice (See block 140 of fig. 1), and terminals, connected to said public network, for receiving said mail arrival notice (See blocks 150, 160, 170 and 180 of fig. 1), wherein: said mail delivery

device includes: mail receiving means, connected to said Internet, for receiving said mail (See block 100 of fig. 1); mail storing means for storing said received mail (See block 126 of fig. 1 and column 6, lines 29 - 30); mail transmitting means for transmitting said received mail to said terminals (See block 134 of fig. 1); user data storage means for storing data of a user of a transmission destination of said mail as user information (See block 130 of fig. 1); notice determination means, when storing of said mail terminates and mail information containing information about a transmission destination of said mail is inputted, for obtaining said user information from the user data storage means and determining whether to perform said mail arrival notice (See block 137 of fig. 1); timer management means for performing timer management (See block 327 of fig. 1); mail arrival notice means for creating mail arrival notice from said mail information (See block 127 of fig. 1); transmission data storage means for storing transmission data of said mail arrival notice (See block 130 of fig. 1); and network connection means, connected to said public network, for transmitting said mail arrival notice to said terminals (See block 122 of fig. 1); said mail arrival notice means include: mail arrival notice creation means for creating said mail arrival notice from said mail and said user information (See block 137 of fig. 1); notice transmission means for creating a transmission request of said mail arrival notice and storing it in the transmission data storage means (See block 137 of fig. 1); network connection control means for converting said transmission request into a format interpretable to said network connection means (See column 6, lines 41 - 45); retransmission data storage means for storing retransmission data required to create a retransmission request, which is a next

transmission request in the case of failure of said transmission request (See block 127 of fig. 1); retransmission control means for creating said retransmission request (See fig. 3A); and retransmission data deletion means for deleting said retransmission data within said retransmission data storage means according to the transmission request of said notice transmission means (See block 137 of fig. 1). said mail arrival notice means, when mail arrival notice to said terminals fails, transmits said mail arrival notice again to said terminals after a predetermined time elapses, and when said mail arrival notice is successfully transmitted, deletes said mail arrival notice data from the device (See block 137 of fig. 1); and further, said mail arrival notice means, when receiving second mail for the same transmission destination as a transmission destination of first mail received previously by said mail receiving means, temporarily stop transmission of a retransmission request for said first mail (See fig. 2. If a second mail is received within the Resend Time Period for a first mail, the Message Review Server will not send a retransmission arrival notice of a first mail).

For claim 10, Hammond teaches The mail delivery device according to claim 8, wherein said mail arrival notice means include transmission data deletion means, when mail arrival notice succeeds, for deleting transmission data of the same notice conditions for the same terminal within said transmission data storage means (See column 8, lines 61 – 63.).

For claim 12, Hammond teaches The mail delivery device according to claim 8, wherein said mail arrival notice means, when mail arrival notice for said second mail fails after temporarily stopping transmission of said retransmission request, cancel the

stop of transmission of said retransmission request for said first mail (See fig. 2. If a second mail is received within the Resend Time Period for a first mail, the Message Review Server will not send a retransmission arrival notice of a first mail).

For claim 13, Hammond teaches The mail delivery device according to claim 8, wherein said mail arrival notice means, when mail arrival notice for said second mail succeeds after temporarily stopping transmission of said retransmission request, delete all retransmission data for the same transmission destination (See column 6, lines 63 - 65).

For claim 14, Hammond teaches The mail delivery device according to claim 8, wherein said mail arrival notice means, when receiving second mail for the same transmission destination as a transmission destination of first mail received previously by said mail receiving means, delete retransmission data for said first mail stored in said retransmission data storage means (See column 6, lines 63 - 65).

For claim 15, Hammond teaches The mail delivery device according to claim 14, wherein said mail arrival notice means, when mail arrival notice of said second mail fail, store retransmission data for said second mail in said retransmission data storage means (See block 127 of fig. 1).

For claim 16, Hammond teaches The mail delivery device according to claim 8, wherein said mail arrival notice means set said number of retransmissions of mail arrival notice (See block 137 of fig. 1).

For claim 17, Hammond teaches The mail delivery device according to claim 8, wherein: said mail arrival notice means include a retransmission control table for storing

correspondences between types of responses from said public network and next transmission processing methods (See block 137 of fig. 1); said network connection control means send a response of said public network to a transmission request of mail arrival notice created by said mail arrival notice creation means to said notice transmission means (See block 134 of fig. 1); said notice transmission means sends said response to said retransmission control means (See block 137 of fig. 1); said retransmission data storage means store, from said response and said retransmission control table, information required to create a retransmission request (See block 137 of fig. 1), which is a next transmission request in the case of failure of the transmission request; and said retransmission control means create said retransmission request (See block 137 of fig. 1).

For claim 18, Hammond teaches The mail delivery device according to claim 8, wherein, in the case where a terminal user has plural terminals of different types, said mail arrival notice means register information of the plural terminals of said user in said user data storage means (See block 127 of fig. 1), and when mail arrives in the user, said mail arrival notice creation means assign priorities to said plural terminals and create mail arrival notice (See column 7, lines 17 - 20).

For claim 19, Hammond teaches The mail delivery device according to claim 18, wherein, when assigning priorities to said plural terminals, said mail arrival notice creation means assign transmission priorities to terminals of transmission destinations, based on one of mail contents, notice conditions, and terminal capabilities, or combinations of two or more of these items (See block 127 of fig. 1).

For claim 20, Hammond teaches The mail delivery device according to claim 18, wherein said mail arrival notice means have data of a table of correspondences between phone numbers of said plural terminals and information about charges for communications with said terminals, and assigns priorities to said plural terminals, using the information about charges for communications with said terminals (See column 7, lines 17 - 20)..

For claim 21, Hammond teaches The mail delivery device according to claim 18, wherein said mail arrival notice means have data of a table of correspondences between carriers of phone numbers and phone numbers of transmission destinations, and communication charges, and, when assigning priorities to said plural terminals, assigns the highest priority to a terminal having the lowest communication charge (See column 7, lines 17 - 20).

For claim 22, Hammond teaches The mail delivery device according to claim 18, wherein, said mail arrival notice means, when said mail arrival notice is unsuccessfully transmitted, decide a terminal of a next transmission destination according to the transmission priorities of said terminals, and retransmits said mail arrival notice (See block 127 of fig. 1).

For claim 23, Hammond teaches The mail delivery device according to claim 8, wherein, in the case where a terminal user has plural terminals of different types, said mail arrival notice means register information of the plural terminals of said user in said user data storage means, and when mail arrives in the user, said mail arrival notice creation means create contents of mail arrival notice in a format suited for a terminal of

a transmission destination, based on one of mail contents, notice conditions, and terminal capabilities, or combinations of two or more of these items (See column 6, lines 40 - 45)..

For claim 24, Hammond teaches The mail delivery device according to claim 8, wherein, in the case where said terminals output a request to obtain mail text containing the terminal capabilities of said terminals and notice conditions after receiving said mail arrival notice, the contents of said mail are created in a format suited for the transmission destination terminal, according to said terminal capabilities and said notice conditions(column 6, lines 40 - 45).

For claim 25, Hammond teaches The mail delivery device according to claim 8, wherein, in the case where a terminal user has plural terminals of different types, information of the plural terminals of said user is registered in said user data storage means, and for at least some of the terminals, terminal information of transfer destination and transfer instructions are registered (See block 127 of fig. 1), the mail arrival notice means make mail arrival notice to said some of the terminals, and transmits arriving mail to a terminal of transfer destination (See block 134 of fig. 1).

For claim 28, Hammond teaches The mail delivery device according to claim 8 in a system including the Internet for delivering mail, a mail delivery device, connected to the Internet, for creating mail arrival notice to notify terminals of the arrival of said mail, a public network, connected to said mail delivery device, for relaying said mail arrival notice, and terminals, connected to said public network, for receiving said mail arrival notice, wherein: said mail delivery device (See Message Review Server, block 132 of

fig. 1) includes: mail receiving means, connected to said Internet, for receiving said mail (See block 305 of fig. 3A); mail storing means for storing said received mail (See block 130 of fig. 1); mail transmitting means for transmitting said received mail to said terminals (See block 355 of fig. 3B); user data storage means for storing data of a user of transmission destination of said mail as user information (See block 127 of fig. 1);, notice determination means, when storing of said mail terminates and mail information containing information about a transmission destination of said mail is inputted, for obtaining said user information from said user data storage means and determining whether to perform said mail arrival notice (See blocks 127 and 137 of fig. 1); timer management means for performing timer management (See column 5, lines 5 - 6); mail arrival notice means for creating mail arrival notice from said mail information (See block 137 of fig. 1); transmission data storage means for storing transmission data of said mail arrival notice (See block 127 of fig. 1); and network connection means, connected to said public network, for transmitting said mail arrival notice to said terminals (See block 122 of fig. 1); and in the case where a terminal user has plural terminals of different types, information of the plural terminals of said user is registered in said user data storage means (See block 127 of fig. 1), and for at least some of the terminals, terminal information of transfer destination and transfer instructions are registered, and the mail arrival notice means make mail arrival notice to said some of the terminals and transmit arriving mail to a terminal of transfer destination (See block 137 of fig. 1).

For claim 29, Hammond teaches A mail delivery device in a system including the Internet for delivering mail (See block 130 of fig. 1), a mail delivery device, connected to the Internet, for creating mail arrival notice to notify terminals of the arrival of said mail (See block 137 of fig. 1), a public network, connected to said mail delivery device, for relaying said mail arrival notice (See block 140 of fig. 1), and terminals, connected to said public network, for receiving said mail arrival notice (See blocks 150 – 180 of fig. 1), wherein: said mail delivery device includes: mail receiving means, connected to said Internet, for receiving said mail (See block 305 of fig. 1); mail storing means for storing said received mail (See block 126 of fig. 1 and column 6, lines 30 - 31); mail transmitting means for transmitting said received mail to said terminals (See block 134 of fig. 1); user data storage means for storing data of a user of transmission destination of said mail as user information (See block 127 of fig. 1); notice determination means, when storing of said mail terminates and mail information containing information about a transmission destination of said mail is inputted, for obtaining said user information from the user data storage means and determining whether to perform said mail arrival notice (See block 137 of fig. 1); timer management means for performing timer management (See block 325 of fig. 3A); mail arrival notice means for

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creating mail arrival notice from said mail information (See block 137 of fig. 1); transmission data storage means for storing transmission data of said mail arrival notice (See block 127 of fig. 1); and network connection means, connected to said public network, for transmitting said mail arrival notice to said terminals (See blocks 122 and 140 of fig. 1); and said terminals have a transfer instruction function, and when said mail arrival notice means make mail arrival notice to the terminals, after receiving said mail arrival notice, transmit transfer instructions and terminal information of transfer destination to said mail arrival notice means, and upon receipt of the transfer instructions (See column 7, lines 17 - 20), the mail arrival notice means transmit arriving mail to a terminal of transfer destination.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammond, in view of Understanding the Basics of Wireless Communications, 3-18 to 3-19, Telecommunications Research Associates, 1985 – 2008, hereinafter Telecommunications Research Associates.

8. Hammond teaches each and every limitation of claims 8 and 18 from which claim 26 depends. Hammond also teaches each and every limitation of claim 8 from which claim 27 depends. However, Hammond fails to explicitly teach information about a transfer destination, registering transfer instructions, having arrival mail transmitted to a terminal of the transfer destination, a transfer instruction function, transmitting transfer instructions and terminal information of the transfer destination to the mail arrival notice means and having the mail arrival notice means transmit arriving mail to a terminal of the transfer destination. Conversely, Telecommunications Research Associates does in fact teach these limitations. Telecommunications Research Associates teaches a cellular handoff consisting of a transfer destination, registering transfer instructions, having a phone call transmitted to a terminal of the transfer destination, a transfer instruction function, transmitting the transfer instructions and terminal information of the transfer destination to the phone call arrival notice means and having the phone call arrival notice means transmit the arrival phone call to a terminal of the transfer destination. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have combined the teachings of Telecommunications Research Associates to implement what is taught by Hammond in order to have a cellular handoff of a communication to a different cell.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Namekawa, U. S. 6237027 (2001); Definition of SMTP http://searchexchange.techtarget.com/sDefinition/0,,sid43_gci214219.00.html; Definition of IMAP http://searchexchange.techtarget.com/sDefinition/0,,sid43_gci214022.00.html.
10. <http://electronics.howstuffworks.com/cell-phone3.htm>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT BILAS whose telephone number is (571)270-5658. The examiner can normally be reached on Monday - Thursday, Alt. Friday, 7:30am -5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Robertson can be reached on 571-272-4186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. B./
Examiner, Art Unit 4121

/RAMY OSMAN/
Primary Examiner, Art Unit 4121